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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,190	06/19/2001	Thomas Gassenmeier	H3486 PCT/US	7590

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/787,190

Applicant(s)

GASSENMEIER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of reply filed on January 30, 2002. Claims 7-25 are pending. A claim rejection under 35 U.S.C. § 112 is maintained. Claim rejections under § 103 are withdrawn, and new rejections are made.

#### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 25 are rejected, as the term "enhancing" is a relative term. It is noted that applicants argue, in response to office action dated August 16, 2001, that the moisturizing properties are "enhanced" in comparison to the original moisturizing properties of the specific formulation disclosed in the specification. However, it is viewed that the "original moisturizing properties" of comparison formulations cannot be read into the instant claims. Examiner views that the rejection is proper as the metes and bounds of the scope of the claims are unclear.

The remaining claims are rejected as based upon an indefinite base claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 7-9, 13, and 15 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Sun et al. (US 5993787) ("Sun").

Sun discloses cosmetic composition comprising propylene carbonate and at least one cosmetic or therapeutic cosmetic agents, such as glycerol. See abstract; Product formulations shown in col. 10. Instant claim 15 is met since glycerol is conventionally used in hair care compositions. See Flick, Cosmetic and Toiletry Formulations p.186 (teaching glycerin used in a hair care composition).

Applicants' arguments filed on January 30, 2002 in response to office action dated August 16, 2001, have been fully considered. While applicants argue that the claimed invention is a new use of a known compound, however, examiner views that, in this case, applicants are not claiming a method of using cyclic carbonate to moisturize a substrate. Rather, the present claims are

directed to a method of using a *composition comprising cyclic carbonate and other cosmetic components* to moisturize a substrate.

Examiner considered the ruling in Bristol-Myers Squibbs Co. v. Ben Venue Labs, Inc., cited by applicants, which holds that new uses of a known composition of matter may be patentable. See 246 F.3d 1368, 1376, 58 U.S.P.Q. 2d. 1508 (Fed. Cir. 2001). In this case, however, examiner views that the instant claims are not directed to a new use of a known composition. Applicants are claiming a topical use of a cosmetic composition comprising cyclic carbonate and other cosmetic compositions, which is disclosed in the prior art.

In reply filed on January 30, 2002, applicants further cited the court's decision that "newly discovered results of known processes directed to the same purpose are not patentable because such results are inherent." Pursuant to this ruling, the alleged newly discovered moisturizing effect resulting from topically applying the cosmetic composition shown in Sun, would not constitute patentability, as such results are deemed inherent. Thus, rejection under § 102 is deemed proper.

2. Claims 7-10, 13, and 15 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Cowton et al. (US 6299889 B1) ("Cowton").

Cowton discloses cosmetic compositions containing organic carbonate such as propylene carbonate and other conventional additives such as glycerin, propylene glycol and fragrance. See Table 2. The rejection is viewed proper for the reason indicated above.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 7-10, 13-15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinh et al. (US 5540853) ("Trinh").

Trinh teaches skin and hair care compositions comprising liquid carrier. See col. 2, lines 35 – 52. The reference teaches that propylene carbonate is a conventionally used, preferred carrier for hair care compositions. See col. 30, lines 36 – 43. Trinh further teaches to use, in addition to the liquid carrier (e.g., propylene carbonate), humectants, moisturizers, and/or emollients for moisturizing benefits. See col. 43, lines 25 – 51; col. 44, lines 29 – 43; col. 45, lines 25 – 29.

It is noted that instant claims are directed to a method of providing (enhancing) moisturizing properties to a composition by adding cyclic carbonate *and other cosmetic ingredients*. One having ordinary skill in the art would have expected that the moisturizing properties of the disclosed composition would be naturally present therein.

2. Claims 7-12, 15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murase (US 4801331).

Murase teaches nail lacquer remover comprising 30-65 % by weight of solvents such as propylene carbonate and glycerin carbonate. See col. 1, lines 41 – 49. The reference teaches that such solvents overcome the disadvantage of the prior arts "which tend to extract oils and moisture from the nails". See col.

1, line 7 – 23. Murase further teaches that the carbonates used in the invention “already have a high degree of wettability”, therefore does not requires surfactants. See col. 2, lines 44 – 52. The reference also teaches to use additives such as oils or humectants may be added in the invention. See col. 2, lines 53 – 54.

Given the teaching that cyclic carbonates have high level of wettability in Murase, one having ordinary skill in the art at the time the invention was made would have expected that the moisturizing properties would be naturally present in the prior art compositions.

3. Claims 13, 14, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinh, as applied to claims 7-10, 13-15, and 17-24 above, and further in view of Murase.

Trinh, discussed above, fails to teach glycerin carbonate.

Murase, also discussed above, teaches the wettability of glycerin carbonate. One having ordinary skill in the art would have known that the disclosed cyclic carbonates therein are conventionally used solvents in cosmetic art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the solvents of the hair care compositions in Trinh with glycerin carbonate, as motivated by the teachings in Murase, because of the expectation that the cyclic carbonate would provide wettability to the composition while using lesser amount of surfactants.

***Response to Arguments***

Applicant's arguments with respect to claims 7-25 in response to office action dated August 16, 2001, have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
April 18, 2002

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GROUP 1200